

REMARKS

Applicants note that while the Examiner has checked the box stating, "This action is FINAL" in the Office Action Summary, the July 9, 2004 Office Action otherwise appears to be non-final. Furthermore, PAIR lists the July 9, 2004 Office Action as non-final. Thus, Applicants have treated the July 9, 2004 Office Action as non-final.

Claims 1-5, 7-13, 15, 18, and 21-44, of which claims 1, 8, 9, 15, 18, 21, 26, 27, 30, 33, 36, 37, and 43 are independent in form, are presented for examination.

Claim Rejections – 35 U.S.C. § 102

The Examiner has rejected claims 15, 18, and 26 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,265,104 ("Hull"). Claims 15 and 18 recite a method of making a metal-air battery, the method comprising placing a cathode tube in a can having a rectangular cross section. Claim 26 recites a method of making a metal-air battery, the method comprising placing a cathode tube in a can having a triangular cross-section.

But Hull does not anticipate claims 15, 18, and 26, at least because Hull does not disclose or suggest placing a cathode tube in a can having a rectangular or triangular cross-section. Hull discloses metal-air batteries that can be in the form of prismatic cells. (See, e.g., Hull, col. 6, lines 35-41.) The Examiner has asserted that, "since various embodiments of prismatic cells exist, prismatic can have a rectangular or a triangular cross section." (July 9, 2004 Office Action, page 5.) But the mere mention of a generic class or genus of cross-sectional shapes, without more, cannot anticipate Applicants' claims to a species of cross-sectional shape. As the Examiner has conceded, the genus of prismatic cross-sectional shapes encompasses different types of cross-sectional shapes (e.g., rectangular, triangular). In comparison, Applicants' claims cover the recited species of either a rectangular cross-section or a triangular cross-section. Accordingly, Applicants request that the rejection of claims 15, 18, and 26 be reconsidered and withdrawn.

Applicant : William McHugh, et al.  
Serial No. : 09/692,869  
Filed : October 20, 2000  
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Attorney's Docket No.: 08935-218001 / M-4926

### **Claim Rejections – 35 U.S.C. § 103**

The Examiner has rejected claims 1-5, 7-13, 15, 18, and 21-44 under 35 U.S.C. § 103(a) as unpatentable over Hull in view of U.S. Patent No. 5,716,726 (“Cheiky”). However, at the time the claimed invention was made, both the claimed invention and the subject matter of Hull were owned by the same company or subject to an obligation of assignment to the same company (the Gillette Company). Thus, under 35 U.S.C. § 103(c), Hull is disqualified as § 102(e) / § 103(a) prior art against the claims of the subject application. Applicants accordingly request that the rejection of claims 1-5, 7-13, 15, 18, and 21-44 be withdrawn.

### **Information Disclosure Statement**

Applicants filed an Information Disclosure Statement for the subject application in the U.S. Patent and Trademark Office on June 8, 2004, but have not yet received a copy of the initialed 1449 form from the Examiner. Applicants have enclosed a copy of the 1449 form with this Reply, and request that the Examiner provide confirmation that the cited references have been reviewed.

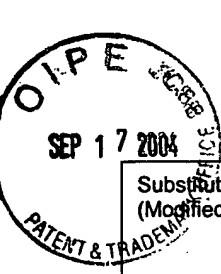
Applicants believe that the claims are in condition for allowance, which action is requested. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: SEPTEMBER 14, 2004

  
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Tu N. Nguyen  
Reg. No. 42,934

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906



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Substitute Form PTO-1449 (Modified)	U.S. Department of Commerce Patent and Trademark Office	Attorney's Docket No. 08935-218001	Application No. 09/692,869
<b>Information Disclosure Statement by Applicant</b> (Use several sheets if necessary)  (37 CFR §1.98(b))		Applicant William McHugh, et al.	
		Filing Date October 20, 2000	Group Art Unit 1745

U.S. Patent Documents							
Examiner Initial	Desig. ID	Document Number	Publication Date	Patentee	Class	Subclass	Filing Date If Appropriate
	AA	6,350,537	02/26/02	Pedicini			
	AB	5,299,877	04/05/94	Birden			
	AC	4,180,624	12/25/79	Winsel			
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

Foreign Patent Documents or Published Foreign Patent Applications							
Examiner Initial	Desig. ID	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation Yes      No
	AL	WO 00/36696	06/22/00	PCT			
	AM						
	AN						
	AO						
	AP						

Other Documents (include Author, Title, Date, and Place of Publication)		
Examiner Initial	Desig. ID	Document
	AQ	
	AR	
	AS	
	AT	

Examiner Signature	Date Considered
EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	